Supreme Court, U.S.
FILED

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NO. _____

In the
Supreme Court of the United States

GERSH KORSINSKY,

Petitioner,

vs.

W. Dudas, DIRECTOR, PATENT AND TRADEMARK OFFICE, *Respondent(s).*

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

PETITION FOR WRIT OF CERTIORARI

GERSH KORSINSKY
1236 – 49th Street, Apartment 4B
Brooklyn, New York 11219
(713) 435-1107

Petitioner Pro Se

BEST AVAILABLE COPY

QUESTIONS PRESENTED

Petitioner Gersh Korsinsky believe that US Congressional Acts by the nature and terms using, which governs all patent cases, conflicts with the Clause 8, which is the foundation upon the national patent laws shall rest, and conflicts with the numbers Constitutional provisions, statutes, US congress Acts, common laws, and federal laws, applied to free expression, arts, personal property and intellectual property, contract, trade natures, etc

Constitutionality to promote the progress of science and useful arts by a designed system with tricks and traps that duped ordinary creative persons into disclosing their inventions and paying substantial charges fees, invest substantial sum and times and efforts only to have their
Inventions later confiscated, such as follow:

Termed, "patent expiration from fails timely paid "patent maintenance substantial fees charges", without prepaying and requires be treated as a prudent person treats its most important life making business, including prior to husband and wife relationship nature. That requires serious investments decisions making, including limiting or stop innovations to save from inventor's invention confiscation;

Termed, "Six Years statute limitation "for infringement discovery and commence actions matters:

Patent protection invalidism or/and weakness, subjected to numbers of patents that protects the same inventions and numbers and legal quality professionalism, which requires not nature for ordinary creative persons such substantial investments; and subjected to examiner's
requisiteness in invention disclosure interfering during patent issues processing, and terms etc. ;

Termed, an invention must display ingenuity not higher than the work of a mechanic skilled in the art that requires numbers patents and claims for each invention, and legalized patent infringement by simple alterations;

By Congress declaring a constitutional standard of patentability for the mental processes, which have been traditionally required, the Court doing the ultimate weighing not the Congress is which created administrative legalization of patent infringement and confiscation personal private intellectual property.

Termed, abandoned application for a patent from filing, publishing and during processing application for a patent by not securing the rights to inventor from not satisfying the imposed administrative requirements, such substantial fees penalties, tax nature fees charges, examiner's in invention disclosure interfering, including Terminology, language, meanings, drawings, time s response, etc. matters

Petitioner Gersh Korsinsky believe that any US Congress Acts imposing any conditions ,such substantial fees charging ,other than prior search as its is and recording or examiners interfering with invention disclosure , or policies, regulations or laws, tax nature, penalties, etc., that limits or jeopardize securing exclusive rights, other than limiting times upon expiration of the period originally specified, to protect individual independent inventors only, by which US Constitutional Commands Congress to promote the progress of science and useful arts only, conflicts with US Constitutional commands, such as follow:

Patentable inventions, which is a mental achievements of creative individuals, top's standard qualifying to the work of a mechanic skilled in the art standard, with combined imposing a large numbers of limitations rights to inventors, using as some of system in encouraging businesses to large scale patenting;

by using not
protected or weak inventions of individual inventors be professional high legal protected by, generated by large patent numbers, rewarding professional businesses, conflicts Constitutional terms securing to inventors the exclusive rights to their respective Writings and Discoveries (using the term "invention" rather than Constitutional term "Discovery" for
a minimum standard qualification), and term "useful Arts" (rather using others terms than arts that taken physical form come from the application of the law of nature to a new useful end).

By named "abandoned application for a patent", during processing applications for a patent, requiring high special level legal professionalism and substantial fees charges for each claim and experience to drafting claims by special approved lawyers to their inventions and paying;

By examiner interfering with invention disclosing, after making public as its is, such named "not defined inventor's possession of an invention" or "obvious to a person having ordinary skill in the pertinent art (without providing qualification requirements), from examiner difficulty to language, terminology and drawing understand;

By ignoring of Constitutional standard of patentability and securing to inventors the exclusive right as a constitutional commands, with congressional conditions of the patentability that interferes, taxes, penalized ,
substantial fees charges, policies, professionalize arts and writing and laws of innovation and writing matters, such contains or generates tricks and traps that duped ordinary creative persons into disclosing their inventions, invest substantial sum, time and efforts only to having ready access to and use of new items versus, as a whole, in making abandoned application for a patent or/and the

patent invalid or defective or/ and future jeopardize by substantial fees charges named "patent maintenance fees";

By the subjecting of the limiting or eliminating or jeopardizing, etc. of the securing to inventors rights, other than the limited times and prior search nature only, as a qualified ordinary creative persons entity only rewarding for their innovations in encouraging only;

By qualified to securing exclusive rights to professionalism and business and legal natures entity, instead of ordinary creative persons, to encouraging them to using simple engineering modifications of new inventions of ordinary creative persons entity, allowing by imposing laws, policies, standards, taxes nature, penalties, etc.;

By substantial fees charges(other than prior search cost) and by interfering in discloser of the inventions, standards nature(including invention display top level ingenuity), professionalism and legal and business nature of innovation;

By Congress declaring constitutional standard patentability and infringement nature, administrative doing the ultimate weighing intellectual personal property issues not courts etc.

By imposing standard to creative ordinary persons personality, such prudent character, innovation treated as his most life important business, invention must be of the most important for investment, financial status for timely paid substantial fees charges, for saving from automatic confiscation of his invention, etc.

There are key differences between non-exercising or ignoring a Constitutional expressly mandatory authorization, Clause 8 "The Congress shall have Power* To promote the Progress of Science and useful Arts, by securing for limited Times To Authors and Inventors the exclusive Right to their respective**

Writings and discoveries***", And be subjected to the policy direction of the Secretary of Commerce, separated from
other things, governs a some of "Understanding", and by an Act of Congress July 19, 1952 and in 1982 established only one Court of appeals, defined exclusively by its
jurisdiction rather than geographical boundaries, without location convenience, subjected to prejudice to full consideration of the issues, and without right of appeal to the US Supreme Court, and without oral arguments;

In its intent and pernicious in its uses a ready access to and uses of a new inventions of achievement of ordinary creative persons innovation, and substantial investments, such substantial fees charges, time, efforts, etc.;

By large numbers designed systems with tricks and traps, that duped independent ordinary creative persons into disclosing their inventions, and paying substantial money, invest time and efforts; And preventing legal challenging during application for a patent processing;

And after patent issues as intellectual property, be confiscated automatically (such 91% loss patents from not timely paid patents maintenance fees for First Stage only which patent revenue by fee type is 35,8% (FY 2006, etc.)), or by an ordinary USPTO officer or examiner; Despite large numbers of Constitutional and federal common laws requirements;

And Reducing or making Invalid patent power protection, which allowing professional businesses re-filing applications for a powerfully strong patent protection;

And enforcing strict and complicate laws and regulations, subjected to substantial fees charges,

including language and disclosure nature, etc., that interfering with arts, writing and discoveries , that impossible overcoming;

And prevents not patentable inventions be protected by not a patent nature;

LIST OF PARTIES

All parties appear in the caption of the case on the cover page.

IN THE
SUPREME COURT OF THE UNITED STATES
PETITION FOR WRIT OF CERTIORARI

Petitioner respectfully prays that a writ of certiorari Issue to review the judgment below

OPINION BELOW

The opinion of the United States Court of Appeal appears at Appendix App.1- APP.6 to the petition and is April 5, 2007 is unpublished.

The opinion of the United States District Court appears at App. 7-App. 25 to the petition and is September 22, 2005 is unpublished.

JURISDICTION

The date on which the United States Court of Appeal decided my case was April 5, 2007
No petition for rehearing was timely filed in my case.
The jurisdiction of this Court is invoked under
28 U.S. C. 1254 (1)

STATEMENT OF THE CASE

Plaintiff Gersh Korsinsky commenced action on March 11, 2005 (05 Civ.2791(Judge Denise Cote), (S.D.N.Y.)) under the APA, using USPTO final decision dated 02/15/2005 (patent expiration for not timely patent maintenance fees paid) as one from experienced by PTO numbers injuries for a formally bases, seeks review of a challenging the "Understanding" that governs patent laws, substituting Constitutional Clause 8.Art.1, that "... promote the progress of science and useful arts ..."by designed systems with tricks and traps that duped ordinary creative persons into disclosing their inventions as an intellectual personal property and paying substantial sums and invest money, time and efforts only to have later automatic confiscated, suitable for professional commerce patentable protection

REASONS FOR GRANTING THE PETITION

This petition for writ of certiorari should be granted for three principal reasons. First, the Congress with its power limited to times limiting only of securing to inventors the exclusive right to their respective writings and discoveries, which caused to promote the progress of science and useful arts, enacted some of "Understanding" that substitute the Constitutional Clause upon which patent laws rest, exclusive controlled by only one type of Court of Appellate exclusively by its jurisdiction. Which create uncertainty in the not consistent, that rather, Second reason, conflicts, with the requirements of US Constitution; and the constitutionality was not tested, since the Patent Act of 1793, including Congress enactment of the Act of 1952 ; Third, the US Congress Acts encouraging by rewarding businesses to high professional protected large numbers patenting, from not or weak of protected inventions of ordinary creative individuals, as a rewarding business, Despite the fact that administrative infringement or

automatic confiscation intellectual personal or private property conflicts large numbers of US Constitutional requirements, federal and common laws

There is some of "Understanding nature", approved by US Congress Acts, which only one separated from others, governs patents laws, under policy of Secretary of Commerce; Despite US Constitution Clause; Which contains possible violation of Constitutional Congress Acts, federal and common laws ,including Sherman Act(1890), Clayton Act(1914),Federal Trade Commission Act(1914, Robinson-Patman Act(1936), Per se violations); Without ordinary Court review and without any Constitutionality challenging , that the writ will be in aid of the only one Court's Appellate exclusively by its jurisdiction.

That exceptional circumstances warrant the exercise of the Court's discretionary powers, and that adequate relief cannot be obtained in any other form or from any other court, and importance the issues to the public beyond parties involved.

CONCLUSION

The petition for a writ of certiorari should be granted.

Dated: May 17, 2007
Brooklyn , New York

Respectfully submitted,

Gersh Korsinsky, Petitioner.

1236 49th Street, Apt. 4B,
Brooklyn, New York 11219
1-718--435-1107

NOTE: This disposition is nonprecedential.

2007-1029

United States Court of Appeals for the Federal Circuit

GERSH KORSINSKY, Plaintiff-Appellant,

v.

W. Dudas, DIRECTOR, PATENT AND TRADEMARK OFFICE, Defendant-Appellee.

DECIDED: April 5, 2007

Before SCHALL, Circuit Judge, ARCHER, Senior Circuit Judge, and GAJARSA, Circuit Judge.

PER CURIAM.

Appealed from: United States District Court for the Southern District of New York Judge Denise Cote

DECISION

Gersh Korsinsky is the owner of U.S. Patent No.4,736,447 ("the '447 patent"), covering a "video computer." After his patent expired for failure to timely pay maintenance fees, Mr. Korsinsky filed a petition to reinstate the patent, which was denied by the United States Patent and Trademark Office ("PTO"). Subsequently, Mr. Korsinsky filed an untimely request for reconsideration of that decision. The PTO denied the motion for reconsideration because it was untimely and because it failed to show the required unavoidable delay in paying the maintenance fees. Mr. Korsinsky then filed suit against Jon W. Dudas ("Director"), the Director of the PTO, in the United

States District Court for the Southern District of New York, seeking relief under the Administrative Procedure Act ("APA") and other statutory and constitutional provisions. In due course, the district court granted the Director's motion for summary judgment on the APA claim. Korsinsky v. Dudas (Trial Court Decision). No. 05-CV-2791, slip op. at 10 (S.D.N.Y. Sept. 22, 2005). The district court dismissed the remaining claims pursuant to Federal Rule of Civil Procedure 12(b)(6) for failure to state claims upon which relief could be granted, jd. at 11-15. Mr. Korsinsky now appeals to this court.[1]

ON

I.

The '447 patent issued on August 26, 1985, with a maximum term of seventeen years from that date. Under 35 U.S.C. § 41 (b), to maintain the patent's validity, Mr. Korsinsky was required to pay maintenance fees to the PTO at three-and-a-half-, seven-and-a-half-, and eleven-and-a-half-year intervals from the date of issue. The statute includes a six-month grace period after each of those dates, during which the owner of the patent may make the required payments and maintain a patent's validity. Mr. Korsinsky failed to make the first required maintenance payment at the required three-and-a-half-year mark and during the grace period. See Trial Court Decision, at 2-3. Therefore, on April 6, 1992, after the grace period for the three-and-a-half-year maintenance fee had expired, the '447 patent expired. See 36 U.S.C. § 41 (b).

On April 29, 2004, Mr. Korsinsky filed a petition seeking to have the '447 patent reinstated. Trial Court Decision, at 2. Mr. Korsinsky explained that he had failed to pay the maintenance fee was because "the notice of maintenance fee was not received." id. On May 17, 2004, the PTO dismissed Mr. Korsinsky's petition because the lack of receipt of the reminder was not sufficient to show unavoidable delay and because Mr. Korsinsky had not included the now due seven-and-a-half- and eleven-and-a-half-year maintenance fees. jd. 2-3. The PTO informed Mr. Korsinsky that he could either file a request for reconsideration, containing information proving that the delay in paying the fee was unavoidable, or he could request a refund of the three-and-a-half-year maintenance fee he had included with his petition.]d_. at 3. The PTO also informed Mr. Korsinsky that any request for reconsideration had to be filed within two months, |d. On June 1, 2004, Mr. Korsinsky requested the refund. jdL

Thereafter, on September 8, 2004, Mr. Korsinsky filed an untimely request for reconsideration.]d_. In the request, Mr. Korsinsky stated that he had been unable to pay the maintenance fees because all of his assets were under joint control with his wife and she had refused to permit him to pay the fees.

[1] Mr. Korsinsky originally appealed to the United States Court of Appeals for the Second Circuit, but the case was transferred to this court because it arises under 28 U.S.C. § 1338. See Holmes Group. Inc. v. Vornado Air Circulation Svs.. Inc., 535 U.S. 826, 829 (2002); Star Fruits S.N.C. v. United States, 393 F.3d 1277, 1281 (Fed. Cir. 2005); see also 28 U.S.C. § 1295(a)(1).

]cL The request included all past-due maintenance fees. Id_. at 4.

The Commissioner of the PTO requested evidence from Mr. Korsinsky "to establish that the instant petition shc uld not be dismissed as untimely." IcT Mr. Korsinsky responded that he had not received the maintenance fee reminder, his wife had prevented him from paying the fees, and he did not want to publicize "family secrets." Id. Mr. Korsinsky included a copy of an agreement between himself and his wife that "[a]ll future investment and like will be by joint agreement and authorization only." He also included three affidavits from his wife, in which she stated that she had previously opposed paying the maintenance fees but now authorized their payment. jdL at 4-5. On February 15, 2005, the Commissioner denied Mr. Korsinsky's request for reconsideration as both untimely and meritless. jd. at 5.

Mr. Korsinsky then filed suit against the Director in the United States District Court for the Southern District of New York under the APA, seeking reversal of the PTO's decision. Mr. Korsinsky also included claims under the Takings Clause of the Fifth Amendment, the Paperwork Reduction Act, the Privacy Act, and The Freedom of Information Act. As noted, the district court granted the Director's motion for summary judgment on the APA claim, jd at 10. At the same time, the district court dismissed the remaining claims under Federal Rule of Civil Procedure 12(b)(6) for failure to state claims upon which relief could be granted.]d_.

at 11-15. This appeal followed. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(1).

II.

We review the district court's grant of summary judgment and dismissal for failure to state a claim de novo. Star Fruits, 393 F.3d at 1281 (summary judgment); Univ. of W. Va. Bd. of Trs. v. Vanvoorhies, 278 F.3d 1288, 1295 (Fed. Cir. 2002) (failure to state a claim). Under the APA, we only "hold unlawful and set aside agency action . . . found to be . . . arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law." 5 U.S.C. § 706(2); Star Fruits, 393 F.3d at 1281.

Mr. Korsinsky's main argument on appeal is that the PTO has designed a system with tricks and traps that duped him into disclosing his invention and paying substantial sums only to have his invention later confiscated. He argues that this system violates Article I, Section 8, clause 8 of the United States Constitution, which grants Congress the power "[t]o promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

We agree with the district court that the maintenance fees and the patent system put in place by Congress and the PTO do not conflict with the Constitution. Congress has mandated the maintenance fees, and the PTO has properly enforced that requirement. See 35 U.S.C. § 41; 37 C.F.R. § 1.378(b). Moreover, we see no error in the ruling of the district court that Mr. Korsinsky failed to meet his burden of showing that the delay in filing his motion for

reconsideration was unavoidable. Trial Court Decision, at 9. As the district court pointed out, the Commissioner offered several grounds to deny Mr. Korsinsky's motion: it was undisputedly two months late; he failed to include the agreement with his wife with his original filing; and he failed to prove the agreement's authenticity or how the agreement actually prevented him from paying the maintenance fees.]d_. at 9-10. We agree with the district court that in light of this evidence, the Commissioner's decision is not arbitrary or capricious.

III.

As for Mr. Korsinsky's claims under the Takings Clause of the Fifth Amendment, the Paperwork Reduction Act, the Privacy Act, and The Freedom of Information Act, we have reviewed Mr. Korsinsky's various arguments and have found them to be without merit. The district court did not err in dismissing those claims. For the forgoing reasons, the judgment of the district court is affirmed.

2007-1029

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

GERSH KORSINSKY,

Plaintiff,

-v-

NICHOLAS GODICI, Commissioner of Patents, United States Patent and Trademark Office,

Defendant.

05 Civ. 2791 (DLC) OPINION AND ORDER

Appearances:

For the Pro Se Plaintiff
Gersh Korsinsky
1236 49th Street, Apt. 4B,
Brooklyn, New York 11219

For the Defendant:

David N. Kelley
United States Attorney
Kristin N. Vassallo
Assistant United States Attorney
Southern District of New York
86 Chambers Street
New York, New York 100 07

DENISE COTE, District Judge:

APPENDIX B

Plaintiff Gersh Korsinsky ("Korsinsky") has brought this action pursuant to, among other things, the Administrative Procedures Act ("APA"), 5 U.S.C. § 701 et seg., to review a decision by the Commissioner of Patents, United States Patent and Trademark Office ("Commissioner"), who refused to reinstate U.S. Patent Number 4,736,447 ("Patent") after Korsinsky failed to paythe Patent's maintenance fee. The Commissioner has moved for summary judgment, claiming that the decision was neither arbitrary nor capricious, and that the remainder of the Complaint should be dismissed for failure to state a claim. For the following reasons, the motion is granted.

BACKGROUND

The following facts are drawnf rom the administrative record filed by the Commissioner. According to the Complaint, Korsinsky filed for a patent on a "Video Computer" on August 26, 1985. The Patent was issued on April 5, 1988. The maximum term for the Patent was seventeen years from the date of issuance. Korsinsky was required to pay maintenance fees three and one half years from the date of issuance, and again seven and one half years and eleven and one half years from the date of issuance, in order to prevent the Patent from expiring

prematurely. After a six month grace period lapsed without payment of the first maintenance fee, the Patent expired by operation of law.

On April 29, 2 0 04, Korsinsky filed with the Commissioner a "Petition To Accept Unavoidably Delayed Payment of Maintenance Fee in An Expired Patent" to reinstate the Patent. Korsinsky explained his failure to pay the maintenance fee by stating that "the notice of maintenance fee was not received," and he included payment of the first maintenance fee.

On May 17, the Commissioner's Office of Petitions issued a decision dismissing Korsinsky's petition because his alleged failure to receive a maintenance fee reminder was not sufficient to show unavoidable delay, and because he had not included payment of the 7.5 year and 11.5 year maintenance fees. The decision also informed Korsinsky that he could either file a request for reconsideration or request a refund of the first maintenance fee he had submitted. The decision noted that if Korsinsky chose to file a petition for reconsideration, he would have to

> supply <u>any</u> and <u>all</u> relevant information and documentation with his request for reconsideration. The Commissioner's decision will be based solely on the administrative record in

> existence. Petitioner should remember that it is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if the petitioner provides insufficient evidence to "show" that the delay was unavoidable. Therefore, if the request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

(Emphasis in original.) The decision also noted that the deadline for filing a request for reconsideration was two months from the date of the decision, and that any request had to be accompanied by a non-refundable petition fee of $13 0 and the remaining $2,655 in outstanding maintenance fees.

On June 1, Korsinsky filed a request for a refund of his maintenance fee. On September 8, Korsinsky filed an untimely petition for reconsideration, alleging that he had not paid the maintenance fees because all of his assets were controlled jointly by his wife, who would not permit him to pay the fees. He included an affidavit from his wife stating that she had previously prevented him from paying the fees, but that she

changed her mind after it became apparent that the Microsoft Corporation was infringing her husband's patent. He also included the remaining 7.5 and 11.5 year maintenance fees that he had failed to pay up to that point.

On October 4, the Commissioner issued a Request for Information ("RFI"), which notified Korsinsky that his petition for reconsideration was untimely, informed him that the Commissioner would not consider his request for reinstatement unless he supplied evidence "to establish that the instant petition should not be dismissed as untimely," and directed Korsinsky to provide evidence demonstrating that the delay in paying the maintenance fees was not intentional or avoidable.

On October 28, Korsinsky submitted a response to the RFI, stating that he did not pay the maintenance fees because he did not receive the maintenance fee reminder, his wife prevented him from paying the maintenance fees, and he did not want to publicize "family secrets." Korsinsky explained that he failed to file his petition for reconsideration within the two-month time limit because his wife opposed paying a large sum of money for reconsideration, but changed her mind when Korsinsky discovered infringement

in August 2004. Korsinsky also submitted a photocopy of a handwritten "Agreement" dated December 30, 1984 and allegedly signed by Korsinsky and his wife, that is not witnessed or notarized, and which provides, in its entirety, "Agreement between Gersh Korsinsky and his wife Helen Korsinsky for a joint ownership of the house, located 5515 Fort Hamilton Parkway, Brooklyn, New York 11219. All future investment and like will be by joint agreement and authorization only." Korsinsky also submitted three separate affidavits from his wife, all dated October 12, 2004, stating, respectively, that she opposed paying the maintenance fees, that she authorized payment of $1,155 in fees after a possible infringement was discovered, and that she now authorized Korsinsky to pay all fees necessary to reinstate the patent.

In a decision dated February 15, 2005 ("Decision")/ the Commissioner denied Korsinsky's petition for reconsideration, noting that his petition was untimely, he had failed to submit a request for a waiver of the time limit for his petition for reconsideration as well as the required fee for such a request. The Commissioner also noted that in any event Korsinsky's claims were meritless because he had not proven the authenticity of the Agreement, that the Agreement prevented him from paying

the maintenance fees, or that the entire delay in payment of fees was unavoidable.

Procedural History

Korsinsky commenced this action on March 11, 2 005, alleging among other things that the expiration of the Patent for failure to pay maintenance fees was an "automatic confiscation [of] property without notification," and seeking review of the Decision pursuant to the APA. Korsinsky amended his complaint on May 13, adding claims under the Paperwork Reduction Act ("PRA"), Privacy Act, Freedom of Information Act ("FOIA"), and the Takings Clause of the U.S. Constitution.

DISCUSSION

Summary judgment may not be granted unless all of the submissions taken together "show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Rule 56 (c) , Fed. R. Civ. P. The moving party bears the burden of demonstrating the absence of a material factual question, and in making this determination the court must view all facts in the light most favorable to the non-moving party. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 247 (1986); Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986). When the moving

party has asserted facts showing that the non-movant's claims cannot be sustained, the opposing party must "set forth specific facts showing that there is a genuine issue for trial," and cannot rest on the "mere allegations or denials" of the movant's pleadings. Rule 56 (e), Fed. R. Civ. P.; accord Burt Rigid Box, Inc. v. Travelers Property Cas. Corp., 302 F.3d 83, 91 (2d Cir. 2002) .

Administrative Review

Review of a decision of the Commissioner to deny a petition to reinstate an expired patent for failure to pay maintenance fees is governed by the APA. See Ray v. Lehman, 55 F.3d 606, 608 (Fed. Cir. 1995). The APA provides for judicial review of

"final" federal agency actions. 5 U.S.C. § 704. See Luian v.' Nat'l Wildlife Fed'n, 497 U.S.. 871, 882 (1990) . Under the APA, a court shall "hold unlawful and set aside agency action, findings, and conclusions found to be . . . arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law." 5 U.S.C. § 706(2). See also Dickinson v. Zurko, 527 U.S. 150, 164 (1999). "The arbitrary and capricious standard . . . is highly deferential. This standard requires a reviewing court to sustain an agency action evincing rational reasoning and consideration of relevant

factors." Advanced Data Concepts, Inc. v. United States, 216 F.3d 1054, 1058 (Fed. Cir. 2000) . When applying this standard, "the focal point for judicial review should be the administrative record already in existence, not some new record made initially in the reviewing court." Camp v. Pitts, 411 U.S. 138, 142 (1973). "Generally, a court reviewing an agency decision is confined to the administrative record compiled by that agency when it made the decision." Nat'l Audubon Soc'y v. Hoffman, 132 F.3d 7, 14 (2d Cir. 1997). See also Advanced Data Concepts, 216 F.3d at 1057.

In order for a patent to remain in effect, the patent owner must pay maintenance fees at various points after the patent is issued. 3 5 U.S.C. § 41(b). The first due date for a maintenance fee is three years, six months after the patent is issued; successive fees are due seven years, six months after the patent is issued, and again at eleven years, six months after the patent is issued. Id. "Unless payment of the applicable maintenance
fee is received in the Patent and Trademark Office on or before the date the fee is due or within a grace period of 6 months thereafter, the patent will expire as of the end of such grace period." Id.

> The Director may accept the payment of any maintenance fee required by subsection (b) of this section which is made within twenty-four months after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unintentional, or at any time after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable. If the Director accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period.

35 U.S.C. § 41 (c) (1) (emphasis supplied).

A patentee who fails to pay the required maintenance fee on a patent bears the burden of showing that his delay in payment was unavoidable. See Ray, 55 F.3d at 608. Any petition to accept an unavoidably delayed payment of a maintenance fee must include the required maintenance fees and applicable surcharge, evidence "that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid

timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent," and an explanation of "the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly." 37 C.F.R. §§ 1.378(b) (1)-(3) . See also Ray, 55 F.3d at 608. This requires showing that he "exercised the due care of a reasonably prudent person." Ray, 55 F.3d at 609. "[T]he word 'unavoidable' should apply to ordinary human affairs, and . . . it requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business." Futures Tech., Ltd. v. Quigg, 684 F. Supp. 430, 431 (E.D. Va. 1988). See also In re Mattullah, 38 App. D.C. 497, 514 (D.C. Cir. 1912); R.R. Donnelley & Sons Co. v. Dickinson, 123 F. Supp. 2d 456, 459 (N.D. 111. 2000).

Regulations promulgated by the Commissioner govern reconsideration of a decision to deny a petition to reinstate a patent:

> Reconsideration of a decision refusing to accept a

> maintenance fee upon petition . . . may be obtained by filing a petition for reconsideration within two months of, or such other time as set in the decision refusing to accept the delayed payment of the maintenance fee. Any such petition for reconsideration must be accompanied by [a] petition fee . . . . After the decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

37 C.F.R. § 1.378 (e) . An extension of the two month filing deadline for the petition for reconsideration may be obtained in "an extraordinary situation, when justice requires," provided that the patentee file a petition for a waiver of the deadline and an accompanying petition fee. 3 7 C.F.R. § 1.183.

The Decision was the Commissioner's final agency action in this matter. It is undisputed that Korsinsky filed his petition for reconsideration two months late, and failed to request a waiver of the time limit or pay the petition fee for such a waiver request. Thus, by operation of regulation, the

Commissioner was entitled to deny Korsinsky's petition. This, by definition, was not arbitrary or capricious. Moreover, even if Korsinsky had filed his petition for reconsideration in a timely manner, it was not arbitrary or capricious to deny the petition. Korsinsky's original petition to reinstate the Patent explained that Korsinsky had not paid his maintenance fees because he had not received any reminders from the Commissioner -- in other words, he was not aware of the need to pay such fees. Korsinsky's petition for reconsideration flatly contradicted this original claim, as it alleged that Korsinsky was aware of the need to pay the fees, but was prevented from doing so by his wife due to the Agreement. As the Decision correctly noted, Korsinsky failed to establish the authenticity of the Agreement, failed to raise its alleged existence in the first petition, and failed to show that the Agreement, even if authentic, actually prevented him from paying the maintenance fee. Korsinsky also failed to enumerate any steps he took to try to ensure that he timely paid the maintenance fees. Under these circumstances, the Decision was neither arbitrary nor capricious.

To the extent that Korsinsky relies on an affidavit of David W.R. Brown and its accompanying exhibits,

it is material outside the administrative record and may not be considered, and in any event is irrelevant to these proceedings. For all of these reasons, the Commissioner's decision on Korsinsky's petition for reconsideration is affirmed.

Takings Clause

Korsinsky also claims that the expiration of the Patent for failure to pay maintenance fees constitutes an unlawful government taking in violation of the Takings Clause of the Fifth Amendment to the U.S. Constitution; the Commissioner moves to dismiss this and the remainder of Korsinsky's Amended Complaint for failure to state a claim. To dismiss an action pursuant to Rule 12(b)(6), Fed. R. Civ. P., a court must determine that "it appears beyond doubt, even when the complaint is liberally construed, that the plaintiff can prove no set of facts which would entitle him to relief." Scutti Enters., LLC v. Park Place Entm't Corp., 322 F.3d 211, 214 (2d Cir. 2003) (citation omitted). In construing the complaint, the court must "accept[] as true the factual allegations in the complaint and draw[] all inferences in the plaintiff's favor." Id. If it is clear, however, that "no relief could be granted under any set of facts that could be proved consistent with the allegations," the

complaint should be dismissed. Swierkiewicz v. Sorema, N.A., 534 U.S. 506, 514 (2002).

The Fifth Amendment prohibits the Government from "taking private property for public use without just compensation." Palazzolo v. Rhode Island, 533 U.S. 606, 617 (2001). See also U.S. Const, amend. V; Kelo v. City of New London, 12 5 S. Ct. 2655, 2658 n.1 (2005). A plaintiff's "property interest in a patent accrues only after it has satisfied all mandatory conditions." Fiqueroa v. United States, 57 Fed. Cl. 488, 502 (2003). If a patent expires because a maintenance fee is not paid, "it is not that plaintiff's personal property is taken away . . . but rather the conditions of the privilege are no longer satisfied." Id. at 502-03. Thus, a plaintiff has no "independent property interest apart from satisfying all conditions imposed by Congress." Id. at 503.

Korsinsky therefore does not retain a property interest in the Patent, because he failed to comply with mandatory conditions for the Patent's existence. Accordingly, the expiration of the Patent cannot constitute an unlawful taking, and Korsinsky's claims based on the Takings Clause are dismissed.

Paperwork Reduction Act

Korsinsky argues that the form used by the Commissioner to collect information for a petition to reinstate a patent under 37 C.F.R. § 1.378(b), PTO/SB/65, does not comply with the PRA, and that therefore this Court should "undo all of the penalties" based on the Commissioner's use of a flawed form. The PRA only authorizes litigants to use its protections as a defense -- it does not authorize a private right of action. See 44 U.S.C. § 3512(b); Teledvne, Inc. v. United States, 50 Fed. Cl. 155, 190 (2001). Therefore, Korsinsky cannot sue based on the PRA to invalidate the Commissioner's decision as he does in the Amended Complaint. In any event, the applicable form to which Korsinsky refers, PTO/SB/65, complies with the PRA by displaying a valid control number assigned by the Director of the Office of

Management and Budget and by stating that "[u]nder the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number." See 44 U.S.C. § 3512 (a) . Korsinsky's claims based on the PRA are dismissed.

Privacy Act

Korsinsky argues that the Commissioner violated the Privacy Act by requiring him to reveal personal family information in order to prove an unavoidable delay and reinstate the Patent, and then making that information public as part of the Patent's file. He also contends that a required Privacy Act statement was missing from the PTO/SB/65 form.

The Privacy Act permits federal agencies to release records to the public where such disclosure constitutes a "routine use." 5 U.S.C. §§ 552a(b)(3), (e)(4)(D). The Commissioner's system of records provides notice that records concerning issued patents are "open to public inspection" as a "routine use." 46 Fed. Reg. 63498, 63548-49 (Dec. 31, 1981). The Privacy Act requires agencies keeping records to "inform each individual whom it asks to supply information, on the form which it uses to collect the information or on a separate form that can be retained by the individual" of, among other things, the routine uses which may be made of the information. 5 U.S.C. § 552a(e)(3). The Commissioner provides a Privacy Act Statement on a separate form that states that " [a] record from this system of records may be

disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151." The Statement goes on to state that "a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent." Applicable regulations also state that specifications, drawings, and all papers relating to a patent filing are "open to inspection by the public." 37 C.F.R. §§ 1.11, 1.14(a)(1)(I).

The Commissioner did not violate the Privacy Act by placing Korsinsky's information in the public record because such an action is authorized as a routine use of that information. Likewise, the Commissioner's Privacy Act Statement does not have to appear on the PTO/SB/65 form, but rather, can be made available in a separate document, which the Commissioner has done. Korsinsky therefore fails to state a claim based on a violation of the Privacy Act.

Freedom of Information Act

Korsinsky argues that the Commissioner has denied access or otherwise withheld documents in violation of FOIA. FOIA grants federal courts "jurisdiction to enjoin [an] agency from withholding agency records and to order the production of any gency records improperly withheld from [a] complainant." 5 U.S.C. § 552(a)(4)(B). In order to state a claim under FOIA, however, a plaintiff must allege that a request for records was made to an agency and the agency improperly withheld records responsive to this request. See Kissinger v. Reporters Comm. for Freedom of the Press, 445 U.S. 136, 150 (1980); Goldaar v. Office of Admin., Exec. Office of the President, 26 F.3d 32, 34 (5th Cir. 1994).

Korsinsky does not allege, however, that the Commissioner ever denied him access to the file for the Patent, or even that he requested any documents from the Commissioner. The Commissioner has no record of any FOIA request made by Korsinsky relating to the Patent. Consequently, Korsinsky fails to state a claim for a violation of FOIA.

CONCLUSION

The motion for summary judgment is granted. The Clerk of Court shall enter judgment for the defendant and close the case, SO ORDERED:

Dated: New York, New York
September 22,2005

DENISE COTE, District Judge